

REMARKS/ARGUMENTS

The Applicants' representative has carefully reviewed the Examiner's Office Action of October 20, 2005, in which the Examiner restated his obviousness rejection from an earlier office action of March 25, 2005. Specifically, the Examiner rejected claims 1-13 and 15-30¹ under 35 U.S.C. 103(a) as being obvious over some combination of Shoji (USPN 5,378,553), Grisamore (USPN 6,132,055), Petzl (USPN 6,499,859), and Sutherland (USPN 5,641,220).

With respect to the Examiners obviousness rejections, the Applicants incorporate by reference their arguments as filed in an amendment dated June 10, 2005 – namely that the cited bicycle art is non-analogous, that the combination of the bicycle art with the grill art lacks a motivation to combine, and that the failure of others suggests that the claimed invention is non-obvious - as supplemented below:

Preamble of the claims:

The Applicants understand that the Examiner renewed his rejections of the claims on the basis that "a preamble is generally not accorded any patentable weight . . ." In response to this argument, the Applicants have amended independent claims 1, 15, and 27 to positively claim a barbecue grill by structuring the claims in Jepson format. The Applicants refer the Examiner to 37 CFR 1.75(e), which instructs that Jepson claiming is permitted, and MPEP § 608.01(m), which instructs that elements recited in the preamble of a Jepson claim are considered part of the claimed combination:

Where the nature of the case admits, as in the case of an

¹ The Applicants recognize that the Examiner has indicated that Claim 14 would be allowable if re-written in independent form.

improvement, any independent claim should contain in the following order: (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) A phrase such as ‘wherein the improvement comprises,’ and (3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

37 CFR 1.75(e).

“The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.”

MPEP Section 608.01(m).

Bicycle art is non-analogous:

The Applicants respectfully disagree with the Examiner that the bicycle art cited by the Examiner, including Shoji, is analogous art. The Applicants respectfully assert that a barbecue grill handle is substantially different from a bicycle handle. For instance, a bicycle handle is attached to a bicycle at a pivot point, wherein the axis about which the bicycle handle rotates is *perpendicular* to the longitudinal axis of the handle. Conversely, a barbecue handle rotates about a pivot axis which is generally *parallel* to the longitudinal axis of the handle. Consequently, the problems associated with directing a light in an appropriate direction during use of a bicycle is substantially different from the problems associated with directing a light during use of a barbecue grill. The Applicants refer the Examiner to the currently amended independent claim 27, wherein the Applicants have positively claimed a hinged connection between the upper and

lower member, wherein a handle attached to the upper member has a longitudinal axis which is parallel to the pivot axis of the hinge.

There is no motivation to combine Shoji with Grisamore:

While the Examiner relies on *In re Fine* and *In re Jones* for the proposition that the motivation to combine can be found in the knowledge generally available to one of ordinary skill in the art, it appears that the Examiner is instead relying solely on the disclosures in Shoji and Grisamore for the motivation to combine. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992). For instance, the Examiner argues that Shoji suggests that an illumination device may be removably attached to a handle while Grisamore teaches a barbecue light where the handle itself is a light-containing tube, “which shows motivation of need to illuminate cooking surface of the barbecue grill.” If the examiner instead intended to rely on the knowledge of a person of ordinary skill in the art for the motivation to combine, the Applicant hereby requests recitation of such knowledge. See *In re Fine*, 837 F.2d at 1075 (noting that “[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”)

If the Examiner is indeed, as the Applicants suspect, relying on the teachings of Shoji and Grisamore, the Applicants respectfully disagree with the Examiner that Shoji and Grisamore include a motivation to combine. As support for the Applicants position, the Applicant refers the Examiner to the facts and holding of *In re Fine*, which are analogous to the issue at hand. The

invention at issue in *In re fine* called for a gas chromatograph, a converter, and a nitric oxide detector. *In re Fine*, 837 F.2d at 1072. The Examiner relied upon a first prior art patent which purportedly disclosed all limitations of the invention, with the exception that the prior art disclosed a sulfur detector instead of a nitric oxide detector, and a second prior art patent which taught the use of a nitrix oxide detector. *Id.* at 1073. The Examiner submitted, and the Federal Circuit rejected, the argument that substitution of one type of detector for another would have been within the skill of the art. *Id.* at 1074-1075. The Federal Circuit held that “teachings of references can be combined *only* if there is some suggestion or incentive to do so” *Id.* at 1075. Notably, the Federal Circuit reasoned that the first reference did not suggest using the arrangement to detect nitrogen compounds and actually warned about adverse affects caused by the presence of nitrogen.

The Applicants respectfully submit that the Examiner’s rejection amounts to an argument that it would have been obvious to substitute one type of handle for another to arrive at the claimed invention, despite the fact that there are substantial differences between the handles (see argument above concerning non-analogous bike art). The Applicants admit that Shoji teaches a headlamp on a bicycle and Grisamore teaches a light-containing handle which illuminates a cooking surface of the grill. However, the Applicants submit that Shoji does not suggest using the headlamp on a barbecue grill handle and Grisamore does not teach attaching a light to the exterior of a handle. Indeed, it is the Applicants belief that Grisamore teaches away from attaching a light to the exterior of a grill handle. Referring specifically to col. 1, ll. 10-20, Grisamore explains that prior art, clamp-on light fixtures for barbecue grills that are designed to

attach to nearby trays or other physical objects are cumbersome, awkward, and expensive and cast shadows on the cooking surface so as to obscure the desired view of food items being cooked. For this reason, the Applicant respectfully asserts that the Examiner has improperly used hindsight (i.e., the Applicants' invention) to obtain the combination.

Newly submitted claims:

The Examiner declined to consider claims 31-44, which were previously submitted in the Amendment of June 10, 2005, on the basis that the claims are directed to an invention that is independent or distinct from the invention originally claimed. The Applicants respectfully disagree with the Examiner and submit that the Examiner has taken too narrow a view as to what the Applicants are claiming. The Examiner asserts that the originally submitted claims relate to modular lights which have manual switches, whereas the newly submitted claims are directed to a light housing which is mounted on a lid and includes a timer switch. The Applicant respectfully disagrees considering that claim 1 and its dependent claims do not recite the "modular" capability, claim 6 calls for the light fixture to be connected to an upper member (or lid) of a barbecue grill, and claim 14 calls for an automatic switch which overrides the manual switch. Furthermore, claim 31 calls for a manual switch which overrides an automatic switch. Nevertheless, since the Applicants are filing an RCE in this case, it is believed that the Examiner can now consider claims 31-44.

Please note that claims 31-44 are based upon claim 16 from issued U.S. Patent 6,851,820, which is related to this application, and include additional limitations.

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Reply to Office action of Oct. 20, 2005

Conclusion:

For the foregoing reasons, the Applicants believe that the claims are sufficiently distinguished from the prior art and are in condition for allowance.

The Applicants believe that a fee is required for submission of the Request for Continued Examination. You are hereby authorized to deduct the required amounts from our Deposit Account No. 02-0400 (Baker & McKenzie). When identifying such a withdrawal, please use the Attorney Docket Number WEB-922-CIP.

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Respectfully,

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